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09/712,743	11/14/2000	Roberta L. Patnode	10655.9500	9259

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EXAMINER

AKINTOLA, OLABODE

ART UNIT	PAPER NUMBER
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3691

MAIL DATE	DELIVERY MODE
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05/21/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/712,743

Applicant(s)

PATNODE ET AL.

Examiner

Olabode Akintola

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8,10,11,14-16,18-29,31,32,34-40 and 43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-8,10,11,14-16,18-29,31,32,34-40 and 43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/6/2007 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 11, 21, 31, 40, 46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, Claims 1, 11, 21, 31, 40 and 46 disclose the step of "compiling data requirements unique to said entity based on at least one of: said financial need, said preferred financial strategy and said economic class, wherein said data requirements include formats and value properties" and "compiling a data entry page based on said data requirement, wherein said data entry page includes said format and said value properties as metadata to

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enforce data entry rules” in view of the current remarks file by applicants on pages 12-13. These steps are not supported or disclosed in the original disclosure and therefore constitute new matter. Applicant is requested to cite relevant portion(s) of the original disclosure that teaches these limitations.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 2, 4-8, 10-11, 14-16, 18-29, 31-32, 34-40, 43-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis USPN (6513019) in view of Jones et al USPN (6021397) (Jones) and further in view of Cheah USPN (7003546).

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Re Claim 1: Lewis teaches a method of creating financial advice applications, comprising; establishing a connection to a client computer having an application program (client workstation with user interface 140, fig. 4, col.10, lines 21-33; col. 5, lines 27-55 and col. 19, lines 1-58) comprising at least one module, wherein each module of said application program corresponds to a financial service (unified internet-enabled user interface that supports browser-based inquiries. Input data are presented to the system via and object-oriented API such as XML that conforms to different formats col. 5, lines 27-55; col. 15, lines 7-29; col.9, lines 8-11 and 33-50); communicating with an authentication server and authenticating a user of said client computer (col. 19, lines 22-36, see also col. 21, lines 16-29); receiving a request from said client computer for financial advice services data related to a current financial position (accessing financial data and information about current and projected balances and positions across customers, accounts, books, funds., and the like (col. 6, line 7-60 and col. 20, lines 1-55); transmitting said request for financial advice services data to said financial advice service (col. 4, lines 50-67 and col.10, lines 55 to col. 11 line 64) wherein establishing a connection to said financial advice service and transmitting said request for financial advice services data to said financial service comprises: establishing a connection to an application services manager (col. 6, lines 61 to col. 7, line 30; see also col. 21, lines 16-29); transmitting a second request to said application services manager for said financial advice services data (col. 6, line 7-60; col. 20, lines 1-55); establishing a connection between said application services manager and said financial advice service (fig. 4 and col.4, lines 50 to col. 5, line 12 and col. 6, line 7-60); transmitting a result of compiling said financial advice services data to said client computer in the form of a financial advice application (col.4, lines 50-65; col. 5, line 14 to col. 6, lines 47 and col. 19, lines 19-65); and scripting

requests from said client computer such that a single request creates a financial advice application including data from a plurality of financial advice services (col. 5, lines 27-55 and col. 21, lines 43 to col. 22, line 39).

Although Lewis shows substantial features of the claimed invention as explained in claim 1, Lewis does not explicitly show at least one lifetime goal, wherein the lifetime goal is related to at least one of education, wealth accumulation, retirement, estate planning, tax planning, survivorship, disability, and long-term care.

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Lewis, as evidenced by Jones.

In analogous art, Jones whose invention is about a financial advisory system for advising a user regarding feasible and optimal portfolio allocations among a set of financial products, disclose a financial advice system for advising a user lifetime goal such saving money to send a child to college (education), saving more money (wealth accumulation), retirement and purchasing (Col. 4, lines 24-34 and col. 6, lines 1-13).

Giving the teaching of Jones, a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Lewis by employing the financial advice service system of Jones in order to provide specific and timely advice to users regarding steps they can take to improve their chances of meeting their financial goals in the most efficient way (Col. 2, lines 41-45 and col. 20, lines 22-30).

Jones further teaches establishing a connection to at least one financial advice service, wherein said at least one financial advice service includes a roadmap service configured to use the financial advice services data to provide financial planning and advice; (fig. 1; col. 5, lines 34-48 and col.

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4, line 24-59); evaluating second request to identify a plurality of financial advice service based on at least one of financial need, preferred financial strategy and economic class; compiling data requirement unique to the entity based on at least one of: said financial need, said financial strategy and said economic class, wherein said data requirement include format and value properties ; compiling a data entry page based on said data requirement, wherein said data entry page includes said format and said value properties as metadata to enforce data entry rules; compiling said identified plurality of financial services and data entry page to form said financial advice service data and transmitting said financial advice service data to said client computer in the form of a financial services application. Jones teaches "*As described further below, on an ongoing basis the financial advisory system 100 may evaluate the user's portfolio against one or more financial goals and may notify the user if progress towards any of the goals has changed in a material way. In subsequent user sessions with the financial advisory system 100, the user's data (e.g., the user's profile information, account holdings, plan parameters, and tax information) may be retrieved from memory on the AdviceServer 110, for example, and the current forecast for the one or more goals may be presented to the user. Additionally, if the ongoing plan monitoring has generated any alerts, they may be presented the user at this time. Alternatively, alerts may be generated proactively by the system and transmitted to the user via a telephone, email, fax, or standard mail messaging system. Based upon the alerts generated by the ongoing plan monitoring, the user may again begin the iterative process of adjusting the decision variables described above (e.g., risk level, savings rate, and retirement age) until the user is satisfied with the likelihood of meeting his/her goal (s).*" (Jones Col. 4, lines 27-33; Col.

6, lines 35-55; Col. 20, lines 7-30 and fig. 4, database 130. See also col. 4, lines 50-67 and col. 11, lines 50 to col. 12 line 4).

Lewis does not explicitly teach the limitation wherein said financial advice is fully executable at said client computer. Cheah teaches the step wherein said financial advice is fully executable at said client computer (col. 10, lines 52-63). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Lewis from a “thin client” (in which some functionality is moved from the server to client) architecture to a full client-side architecture as taught by Cheah in order to reduce the dependency on the server when the server becomes unavailable.

Re claim 2: Lewis teaches the step wherein said first request and second request are the same (Fig. 4; col. 4, lines 50 to col. 5, line 12; col. 6, line 7-60 and col.10, lines 55 to col. 11, line 64).

Re claim 4: Lewis teaches the step wherein said at least one financial advice service includes at least one of leased storage service, a formatting service, library service, repository service, simulator service, an asset allocation service, a business graphics service, a roadmap service, and an equity evaluation service (see Figs. and 4; col.4, lines 50 to col. line 48 and col.11, lines 50 to col. line 152).

Re claim 5: Lewis teaches the step comprising formatting data transmitted between any of said application program, said application services manager, and said at least one financial advice service in a standardized data format (col. 9, lines 33-51 and lines 50-54 and col. lines 11-21).

Re claim 6: Lewis teaches the step wherein said standardized data format is XML (col. 6, lines 1-6; col. 9, lines 37-51 and col. 17, lines 11-54).

Re claim 7: Lewis teaches the step comprising formatting data transmitted between a plurality of financial advice services in a standardized data format (col. 9, lines 33-51; col. 10, lines 50-54 and col. 17, lines 11-54).

Re claim 8: Lewis teaches the step wherein said standardized data format is XML (col. 6, lines 1-6; col. 9, lines 37-51 and col. 17, lines 11-54)

Re claim 10: Lewis teaches the step comprising communicating with registration application configured to allocate TCP/IP port for use financial advice service during client session (col. 19, lines 27 to col. 20, line 23 and col. 21, lines 16-23).

Re claims 11 and 40: Lewis teaches a system and a method for creating financial advice applications as explained in claim 1 above. The claims include similar limitations found in claim 1.

Therefore they are rejected with the same rationale.

Lewis further teaches an advice utility server in communication with said at least one client computer and said at least one application program (fig. 4 shows web enabled client devices 140 with desktop applications conforming to thin client/Web Server architecture that is in communication with information servers 110, 111 or 112 with database 130 having financial service data via Web server 120, col. 10, lines 50 to col. line 24); and at least one financial advice service (information servers or communication with said advice utility server (Web server 120 and database 130), wherein each financial service is configured to receive data from said advice utility server and to transmit data to said advice utility server (Lewis fig. 4, col. 5, lines 13 to col. 6, line 64; col. 10, lines 50 to col. 11, line 55); and Lewis teaches the invention, further comprising a data migration mechanism in communication with said advice utility server,

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wherein said data migration mechanism is configured to convert data transmissions between any client computer, said advice utility server, and a financial advice service into standardized data format (col. 9, lines 33-51 and col. 10, lines 50-54).

As to the lifetime goal limitations see the claim 1 above.

Re claims 14 and 43: Lewis teaches the step wherein said standardized data format is XML (col. 6, lines 1-6; col. 9, lines 37-51 and col. 17, lines 11-54).

Re claim 15: Lewis teaches the step comprising a translator communication with said advice utility server, wherein said translator is configured to translate data transmissions between plurality of financial advice services into standardized data format (col. 9, lines 33-51; col. 10, lines 50-54 and lines 11-54).

Re claim 16: Lewis teaches the step wherein said standardized data format is XML (col. 6, lines 1-6; col. 9, lines 37-51 and col. 17, lines 11-54).

Re claim 18: Lewis teaches the step comprising a registration application in communication with said advice utility server and said financial advice service, wherein said registration application is configured to allocate a TCP/IP port use financial advice service during client session (col. 19, lines 27 to col. 20, line 23 and col. 21, lines 16-23).

Re claims 19 and 44: Lewis teaches the step wherein said financial advice service includes at least one of headless utility, a leased storage service, formatting service, a library service, a repository service, simulator service, an asset allocation service, a business graphics service, a roadmap service, and an equity evaluation service

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(See Figs. 1 and 4; col. 4, lines 50 to col. 5, line 48 and col. 9, lines 37-51).

Re claims 20 and 45: Lewis teaches the step wherein said advice utility server comprises an application services manager configured communicate with said client computer and said financial advice service (col. 6, lines 61 to col. 7, line 30; see also col. 21, lines 16-29).

Re claims 21, 31 and 46: These are computer readable media, device and method claims with similar limitations as claim 1 above; therefore, they are rejected with the same rationale.

Re claims 22 and 32: These claims have similar limitations as claim 2. Therefore, they are rejected with the same rationale. See the rejection on claim 2 above.

Re claims 24 and 34; Lewis teaches the step wherein said financial advice service includes at least one of a leased storage service, formatting service, a library service, repository service, a simulator service, an asset allocation service, business graphics service, roadmap service, and an equity evaluation service (see Figs. 1 and 4; col. 4, lines 50 to col. 5, line 48).

Re claims 25 and 35: Lewis teaches the step comprising processing instructions configured to direct a computer to perform the step of formatting data transmitted between any of said client computer, said advice utility server, and said financial advice service in standardized data format (col. 6, lines 61 to col. 7, line 30; see also col. 21, lines 16-29).

Re claims 26 and 36: Lewis teaches the step wherein said standardized data format is XML (col. 6, lines 1-6 and col. 9, lines 37-51).

Re claims 27 and 37; Lewis teaches the step comprising processing instructions configured to direct a computer to perform the step of formatting data transmitted between a plurality of financial advice services a standardized data format (col. 9, lines 33-51 and col. 10, lines 50-54).

Re claims 28 and 38: Lewis teaches the step wherein said standardized data format is XML (col. 6, lines 1-6 and col. 9, lines 37-51).

Re claims 29 and 39: Lewis teaches the step comprising processing instructions configured to direct computer to perform the step of allocating a TCP/IP port for use by a financial advice service during client session (col. 19, lines 27 to col. 20, line 23 and col. 21, lines 16-23).

Re claim 47: Jones teaches the step wherein said user-supplied data comprises at least one of economic group data and goals (col. 5, lines 52 to col. 6, line 39).

Re claim 48: Jones teaches the step wherein said economic group data comprises at least one of membership data, demographics data, and financial data (col. lines 52 to col. 6, line 39).

Response to Arguments

Applicant's arguments filed 03/06/2007 have been fully considered but they are not persuasive. Applicant argues that neither Lewis, Jones, Cheah, nor any combination thereof, disclose or suggest "compiling data requirement unique to said entity based on at least one of: said financial need, said financial strategy and said economic class, wherein said data requirement include format and value properties" and "compiling a data entry page based on said data requirement, wherein said data entry page includes said format and said value properties as metadata to enforce data entry rules". Particularly, applicant argues that the Jones reference does not adjust which variables are presented to the user based on specific scenario such as, for example, financial need, preferred financial strategy and economic class, and that Jones does not transmit a request to a server to retrieve data requirements based on a client request in order to

compile and present a data entry form with fields constructed in accordance with the type of service requested, financial position and financial goals that are unique to each individual.

Examiner respectfully disagrees. Jones teaches these limitations (see Jones col. 4, lines 27-33:

*“The system may further advise the user regarding actions that may be taken (e.g., save more money, retire later, take on additional investment risk, seek opportunities to expand the investment set) to achieve certain **financial goals**, such as particular retirement standard of living, accumulating a down payment for the purchase of a house, or saving enough money to send a child to college”).* Examiner asserts that the aforementioned financial goals are separate and unique implementation of the invention based on user specific scenario. Consequently, decision variables for each of these financial goals may vary from implementation to implementation. For example, in a retirement planning system, decision variables might include one or more of: risk, level of savings, and retirement age. In contrast, a mortgage analysis package may include decision variables such as cost of house, length of mortgage, and amount of down payment (see Maggioncalda et al (US 5918217) (assigned to the same assignee as Jones) at col. 8, lines 42-50).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Maggioncalda et al (US 5918217) teaches user interface for a financial advisory system (col. 8, lines 42-50)

Moran (US 6430542) teaches a computer implemented program for financial planning and advice system (Figs. 1-54, col. 2, lines 31-37, col. 6, lines 50-58, col. 11, lines 32-50)

Boe et al (US 6236975) teaches system and method for profiling customers for targeted marketing (Figures, col. 6, lines 8-11, col. 7, lines 9-27, col. 8, lines 16-23, col. 10, lines 1-8)

Examiner's Note: Examiner has cited particular portions of the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olabode Akintola whose telephone number is 571-272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OA



HANI M. KAZIMI
PRIMARY EXAMINER